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	Application Number	10/622435 10/622 435	
	Filing Date	07/18/2003	
	First Named Inventor	HUYNH-BA	
	Art Unit	1743	
	Examiner Name	NATALIA LEVKOVICH	
Total Number of Pages in This Submission	14	Attorney Docket Number	DCS-9179


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## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	DADE BEHRING INC		
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Huynh-Ba et al. )  
Serial No.: 10/622,435 ) Group Art Unit: 1743  
Date Filed: 07/18/2003 ) Examiner: Natalia A. Levkovich  
Title: Magazine for Inventorying Reaction )  
Cuvettes in an Automatic Analyzer )  
Atty. Docket No.: DCS-9179 )

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AMENDED APPEAL BRIEF PURSUANT TO 37 C.F.R. §1.191

Sir:

Applicants file this amended Appeal from the decision of the Examiner to the Board of Patent Appeals and Interferences in furtherance to the Notice of Non-Complaint Appeal Brief dated May 10, 2007, relative to the Appeal Brief filed on March 2, 2007 in furtherance to the Notice of Appeal received by the Patent Office on January 9, 2007.

1. Real Party in Interest. The real party in interest in this appeal is the assignee of the application, Dade Behring Inc.
2. Related Appeals and Interferences. Applicants submit that there are no appeals or interferences currently pending or presently intended that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal. A Decision of Petition was previously granted subsequent to a petition under 37 CFR 1.181, filed April 7, 2006, to withdraw the holding of abandonment for the present application; a copy of the Decision is included in the RELATED PROCEEDINGS APPENDIX.

3. Status of Claims. Claims 1- 6 were in the case originally filed on July 18, 2003, as 10/622,435.

Claim 1 was amended on March 17, 2006, in a Request for Continued Examination, to overcome a 103(a) rejection as being unpatentable over Link (US 6,098,819) in view of US Patent 6,321,609 to Mengel et al. Claim 1 was subsequently amended on September 6, 2006, to overcome a second rejection of claim 1 under 103(a) as being unpatentable over Link (US 6,098,819) in view of US Patent 6,321,609 to Mengel et al.

Claims 1-6 are the subject of this appeal and stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over Link (US 6,098,819) in view of US Patent 6,321,609 to Mengel et al.

4. Status of Amendments. Claim 1 now on appeal was last amended on September 6, 2006. Claim 2-6 now on appeal have not been amended. The claims are set out in Appendix 1.

5. Summary of Claimed Subject Matter. The subject matter claimed in the present application is useful in automated biochemical analyzers that employ a combination of analyte specific chemical reagents and reaction monitoring means to assay or determine the presence or concentration of a specific analyte within a liquid sample suspected of containing that particular analyte. It is advantageous that such analyzers have the ability to perform a large number of reaction assays without operator intervention; therefore it is desirable to maintain a large inventory of reaction cuvettes on such analyzers in such a manner that cuvettes may be automatically provided for performing reaction assays therein. In particular, the present invention provides a cuvette magazine having features to inventory cuvettes securely therein regardless of whether the magazine is positioned on the analyzer or removed from the analyzer.

Applicants have provided a cuvette magazine suitable for housing reaction cuvettes that are essentially shaped like a rectangular box, with a mutually opposed front wall and back walls perpendicular to and separating two mutually opposed side walls (Fig. 5) Applicants' claimed magazine comprises a generally rectangular storage cell with upper and lower

portions with an integrated alignment and locking band having two pairs of rails and two locking tabs formed on the exterior of the magazine in the lower portion (Fig. 7). The magazine has having curved front and back surfaces even though the cuvettes stored therein are generally rectangular. The rails and locking tabs are provided in order to vertically align the cuvette magazine and lock it within aligned grooves and recess within the analyzer. A hinged or slideable gate is provided in the lower portion to allow cuvettes to be removed from the magazine and at the same time, to prevent cuvettes from sliding out of cuvette magazine during handling. Specification, page 8, paragraph [0033].

In order to inventory a large number of cuvettes in a relatively small volume, a number of adjacent vertical chutes are formed in the interior of the magazine (Fig. 9) by the curved front and back surfaces and a pair of opposing chute walls, each chute wall having opposing pairs of ribs protruding into the interior of each storage chute. Specification, page 9, paragraph [0034]. Consequently, a large number of reaction cuvettes may be "horizontally" stacked atop one another in each chute and ejected in a singulated stream through the opened gate onto an analytical portion of the analyzer. In one embodiment, the gate is spring-loaded and is adapted to swing outwards from a closed position preventing reaction cuvettes from sliding out of cuvette magazine into an opened position allowing reaction cuvettes to be ejected from the magazine (Fig. 17)

6. Grounds of Rejection to be Reviewed on Appeal. Whether or not claims 1-6 are unpatentable under 35 U.S.C. §103(a) as being obvious over Link (US 6,098,819) in view of US Patent 6,321,609 to Mengel et al.

7. Arguments.

a) Grouping of claims. There is a single rejection being appealed which applies to claims 1-6. Applicants understand and acknowledge that claims 1-6 shall stand or fall together.

b) Claims 1-6 stand rejected under 35 U.S.C. §103(a) as being obvious over Link (US 6,098,819) in view of US Patent 6,321,609 to Mengel et al. These rejections are

respectfully traversed. The following arguments are directed at the patentability of claim 1 since Claims 2-6 depend therefrom and further limit the claimed invention.

The feature relied upon for non-obviousness of the present invention is the fact that Applicant's cuvette magazine is provided with cuvette storage chutes formed in the interior of the magazine by curved front and back surfaces, even though the cuvettes to be stored therein are generally rectangular box-shaped. Link, in contrast and as noted by the Examiner, teaches a magazine comprising a rectangular storage area having opposing walls and divided into two rectangular storage compartments. Link's rectangular storage compartments are used to store rectangular holding plates for pipette tips (Fig. 1, USP 6,098,819). Notwithstanding the teachings of the Link, wherein a rectangular storage compartment is used to store rectangular plates, the present invention provides storage chutes having curved front and back walls to store generally rectangular cuvettes.

The Examiner, in the Office Action dated November 15, 2006, at page 2, notes that "Link does not teach the hinged gate, the locking means inside the magazine, as well as the front and back surface being curved." Mengel discloses a magazine having multiple slots for holding gas sampling tubes and "teaches that the slots are sized corresponding to the sampling tube to be stored". The "slots appear to be curved on a front and back side" (page 3, top).

It is Applicants' position that the present invention is patentable over Link in view of Mengel for the simple reason that both Link and Mengel teach that the interior of a storage compartment or slot ought to have the same general shape as the plate or tube, respectively, being stored therein. Link's plates are rectangular and Link's storage compartments are rectangular. Mengel's tubes are curved and Mengel's slots are apparently curved. In contrast to these accepted teachings of the art of record, Applicant's magazine for holding generally rectangular cuvettes specifically claims storage chutes that have curved on the front and back walls.

The Examiner, in the Office Action dated November 15, 2006, at page 3 “maintains that it would have been within the ordinary skill of an artisan at the time the invention was made to have curved the walls of the magazine in the modified apparatus of Link, in order to adjust its shape to the shape of related equipment, such as a loading station which can be for example, a carousel, or a turntable.” This argument is flawed, however, because as noted above, Link teaches an artisan to employ a generally rectangular compartment (having flat front and back walls) to store generally rectangular plates and Mengel teaches an artisan to employ a generally curved compartment to store generally round pipettes. It would simply be contrary to the teachings of Link and Mengel to store generally rectangular cuvettes in a magazine with curved front and back walls as Applicants have done. In other words, the cited art teaches against the use of a storage chute with curved walls to store a rectangular cuvette and this alone removes any basis for a valid rejection under 35 USC 103(a),

Furthermore, the Examiner states that it would have been “obvious to one of ordinary skill in the art to have curved the walls of the magazine of Link in order to enhance the scope of its (the magazine’s) applicability by adjusting its shape to conventional shape of related equipment, such as, for example, a loading station which in often cases can be a carousel or a turntable” (Office Action dated November 15, 2006, at page 3). Applicants respectfully traverse such a suggestion because it is *prima facie* illogical given the Examiner’s previous position (Office Action dated June 5, 2006, at page 4) that “It would have been obvious to one of ordinary skill in the art to use curved walls where the tubes or cuvettes being stored are round shaped (Mengel) so that tubes have a better fit in the magazine.” In one instance, the Examiner attempts to use Mengel’s curved walls to suggest storing round shaped cuvettes in a magazine and in the other instance, the Examiner attempts to use Mengel’s curved walls to suggest adjusting the shape of a magazine to fit onto a turntable. It would seem clear from this inconsistent use of a single feature in the prior art to make two totally unrelated “obvious to” conclusions that the Examiner has improperly selected features (curved walls) from one reference (Mengel) to support whatever position (ie, curved cuvette storage chute walls in one instance and curved magazine walls in the other instance) is needed to defeat patentability and this is not permissible within the framework of 35 USC 103.

As stated in the MPEP 706.02, in making an obviousness rejection under 35 USC 103(a), MPEP 706.02(j) requires that the Examiner, as a minimum:

"set forth (1) the difference or differences in the claim over the applied reference(s), (2) the proposed modification of the applied reference(s) necessary to arrive at the claimed invention, and (3) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification."

In the text quoted above, the phrase "at the time the invention was made" guards against the use of hindsight when analyzing the patentability of claims and requires the step of casting back to the time of invention and considering then-accepted teachings of the art, guided only by the prior art. In making the present obviousness rejection, the Examiner has pointed to "obvious to one of ordinary skill in the art to have curved the walls of the magazine of Link in order to enhance the scope of its (the magazine's) applicability by adjusting its shape to conventional shape of related equipment, such as, for example, a loading station which in often cases can be a carousel or a turntable" as a motivation for combining the disclosures of both Link and Mendel. However, the Examiner has failed to set forth the required showing of a teaching or motivation within the prior art references to modify Link's storage compartment to specifically require that the front and back walls be curved, especially in face of the fact that Link's plates being stored in the compartment are rectangular. Lacking this motivation, Applicant believes there is no valid basis for combining Mendel's "slots that appear to be curved on a front and back side" with Link's rectangular storage compartment in order to defeat patentability. Applicants thus believe that the rejection over US Patent 6,098,819 to Link in view of US Patent 6,321,609 to Mengel is unsubstantiated, in particular since MPEP 2144 emphasizes that "obviousness cannot be established without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done". In this instance, the present patent applicant requires that the front and back walls be curved even though the cuvette to be stored is generally rectangular and there is no motivating force disclosed within Mengel or Link to make this restriction.

9. Conclusion In view of the above remarks, Applicant respectfully submits that the Examiner has provided no supportable position or evidence that Claims 1-6 are unpatentable under 103(a) over Link (US 6,098,819) in view of US Patent 6,321,609 to Mengel et al. Accordingly Applicants respectfully request that the Board find Claims 1-6 patentable over prior art of record and withdraw all outstanding rejections.

Respectfully submitted,



Date: May 21, 2007

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## CLAIMS APPENDIX

1. (as amended) A magazine for releasably inventorying a plurality of reaction cuvettes to be used in an automatic clinical analyzer, the magazine comprising a generally rectangular storage cell having curved front and back surfaces between a top and a bottom, and a number of storage chutes therein, each chute sized to accommodate generally rectangular reaction cuvettes stacked one atop another therein, the storage chutes being defined by the front and back surfaces and a pair of opposing chute walls, each chute wall having two opposing pairs of ribs protruding therefrom and into the interior of each storage chute.
2. (original) The magazine of claim 1 wherein the front and back curved surfaces do not extend to the bottom of the magazine so that a number of cuvette ejection openings are formed at the front surface of the magazine between the chute walls.
3. (original) The magazine of claim 1 wherein a flat pad smaller than the storage chutes is formed at the lower extremity of each interior chute wall protruding into the interior space of the storage chutes.
4. (original) The magazine of claim 1 wherein a flat ledge smaller than the storage chutes is formed at the lower extremity of each exterior chute wall protruding therefrom and into the interior space of the storage chute.
5. (original) The magazine of claim 1 further comprising an alignment and locking band having two pairs of rails and two locking tabs formed on the exterior, lower portion thereof.
6. (original) The magazine of claim 1 further comprising a hinged gate proximate the bottom of the magazine, the gate spring-loaded by a hinge-spring on the curved front surface, the gate adapted to swing outwards from a closed position preventing reaction cuvettes from sliding out of the magazine to an opened position allowing reaction cuvettes to be ejected from the magazine.

## EVIDENCE APPENDIX

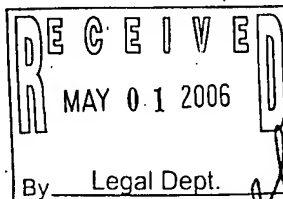
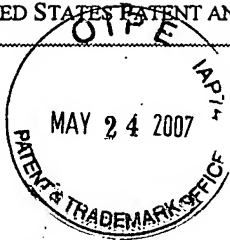
None

## RELATED PROCEEDINGS APPENDIX

A copy of a Decision of Petition that was granted subsequent to a petition under 37 CFR 1.181, filed April 7, 2006, to withdraw the holding of abandonment for the present application may be found on the following 3 pages.



UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
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*[Signature]* COPY MAILED  
APR 25 2006  
OFFICE OF PETITIONS

In re Application of :  
Huynh-Ba et al. :  
Application No. 10/622,435 : DECISION ON PETITION  
Filed: July 18, 2003 :  
Attorney Docket No. DCS-9179 :

This is a decision on the petition under 37 CFR 1.181, filed April 7, 2006, to withdraw the holding of abandonment for the above-identified application.

On September 20, 2005, the Office mailed a final Office action, which set a three-month shortened statutory period for reply. On November 17, 2005, applicants filed an amendment in response to the final Office action. On January 5, 2006, the examiner mailed an Advisory Action, stating that the amendment failed to place the application in condition for allowance. On March 21, 2006 (certificate of mailing dated March 17, 2006), applicants filed a Request for Continued Examination (RCE).

On March 23, 2006, the Office mailed a Notice of Abandonment, which stated that the above-identified application was abandoned in view of applicants' failure to file a proper reply to the final Office action mailed on September 20, 2005. The Notice further stated that the Office received a proposed reply on November 17, 2005, but that it did not constitute a proper reply under 37 CFR 1.113(a) to the final rejection. Lastly, the Notice indicated that a proper reply

under 37 CFR 1.113 to a final rejection consisted only of: (1) a timely filed amendment, which placed the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee), or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114). On April 7, 2006, applicants filed the present petition, a copy of the RCE and a copy of the Fee Transmittal for FY 2003.

In the present petition, applicants averred that the application was not abandoned and requested that the Office withdraw the holding of abandonment. Specifically, applicants stated that they filed a timely response in the form of an RCE on March 21, 2006 (certificate of mailing dated March 17, 2006). Additionally, applicants asserted that the Fee Transmittal for FY 2003 contained a general authorization to charge any necessary fees to the Deposit Account, and therefore, the Office could have charged applicants' Deposit account for a three-month extension of time to respond to the final Office Action of September 20, 2005.

Applicants' assertions are well taken. 37 CFR 1.136(a)(3)(B) provides that: "an authorization to charge all required fees, fees under 37 CFR 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under 37 CFR 1.136(a) to be timely."

The record reveals that applicants filed a general authorization to charge all fees required. Therefore, the Office should have charged applicants' Deposit Account for an extension of time for response within the third month so that the RCE would be filed timely.

Accordingly, the petition is granted. The Notice of Abandonment was mailed in error and is hereby withdrawn. The application is restored to pending status in view of the fact that a response was timely filed and received on March 21, 2006 (certificate of mailing dated March 17, 2006).

The Office will charge the \$1,020.00 extension of time fee for filing a response within the third month to applicants' Deposit Account as authorized.

The matter is being referred to the Technology Center Art Unit 1743..

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

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